

REMARKS

Claims 1, 3-7 and 9-25 have been examined and are all the claims pending in the present application.

I. Claim Rejections Under 35 U.S.C. § 103 to Claims 1, 14 and 18-24

Claims 1, 14 and 18-24 are rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Imaeda (US Patent 5,969,749) in view of Sawachi (US Pub. No. 2003/0011704). Applicants traverse the rejection based on the following comments.

A. Claim 1

In the Response to Arguments section of the current Office Action, the Examiner asserts that paragraph 74 teaches that the power selection switches may be “automatic.” However, paragraph 74 of Sawachi only relates to switches **SW1 and SW2**. On the other hand, on page 5, 2nd and 3rd paragraphs, the Examiner relies on **SW17** for teaching the claimed second switch, asserting that SW17 of Sawachi prevents power consumption by the DSP unit 102. However, Sawachi clearly teaches that the switching of switch SW 17 is **manual** for switching on/off the camera 10 (Fig. 1 and paragraphs 34, 59, 68 and 69). Switches SW1 and SW2 do not prevent power consumption. Instead, they are merely used to manage the sharing of the power supplies from the battery of the camera 10 and/or the battery of the mobile phone 40 (Abstract and paragraph 9). Switches SW1 and SW2 do not interrupt a power supply from any of the components in the camera 10 or in the mobile phone 40, but instead allow the batteries of the camera 10 and the mobile phone 40 to operate independently, or to share power. In fact, when a power level in the battery of the camera 10 becomes low, for example, power from the battery of the mobile phone 40 is routed to the camera 10 so that power is continuously supplied to the components of the camera 10 (paragraphs 75-78). Thus, SW1 and SW2 do not prevent power

consumption - they facilitate it - and thus, the Examiner cannot rely on these switches.

Paragraphs 75-78 do not appear to be applicable for modifying Imaeda as suggested by the Examiner. Furthermore, SW17 is not controlled by a control section¹. Thus, Sawachi fails to correct the deficiencies of Imaeda.

In view of the above, Imaeda, alone or in combination with Sawachi, fails to teach or suggest each and every feature of claim 1. Therefore, claim 1 should be patentable for at least this reason.

B. Claims 14 and 23

Claim 14 recites that “said second switch is automatically switched in conjunction with said first switch in response to a selected mode, wherein said selected mode is said general use mode or said TV telephone use mode.” The Examiner concedes that Imaeda fails to disclose the features of claim 14, but asserts that Sawachi does. As noted above in conjunction with claim 1, the Examiner asserts that switch SW17 of Sawachi teaches the claimed second switch. Thus, the Examiner’s reliance on SW17 is improper for reasons similar to those presented above. Also, *even if* Imaeda could be modified to include switch SW 17, no teaching exists for automatically switching switch SW17 in conjunction with the switch 64, i.e., the alleged claimed first switch, of Imaeda in response to a selected mode.

In addition, switches SW1 and SW2 of Sawachi are switched **independently** of each other and not in conjunction with each other (see Abstract and paragraphs 74-78). Nor are they

¹ The decision in In re Bell makes clear that method steps such as those performed by an operator, do not establish the presence of elemental features of claims for a composition, or an apparatus. In re Bell, 26 USPQ2d 1529 (Fed. Cir. 1993); see also Hewlett-Packard Co. v. Mustek Systems Inc., 67 USPQ2d 1825, 1829-30 (CA FC 2003). That is, the intervening operations performed by a user cannot teach an element of a claimed apparatus. Sawachi fails to teach or suggest that switch SW 17 is controlled by a control section.

automatically switched based on a selected mode. Instead, one of the switches may be automatically switched when a voltage level has reached a voltage lower than a defined voltage in one of devices (i.e., camera 10 or mobile phone 40) (paragraph 76). Thus, even if the Examiner relied on these switches, they still would not teach that the second switch is **automatically switched in conjunction with said first switch in response to a selected mode**, wherein said selected mode is said general use mode or said TV telephone use mode.

In view of the above, Imaeda, alone or in combination with Sawachi, fails to teach or suggest each and every feature of claim 14. Therefore, claim 14 should be patentable for at least this reason. Also, claim 23 should be patentable for similar reasons set forth above.

C. Claim 24

Claim 24 recites that “said second switch is **simultaneously switched automatically in conjunction with** a switching of said first switch in response to a selected mode.” The Examiner asserts that this feature is disclosed by Sawachi. However, nothing in Sawachi teaches or fairly suggests this feature. As noted above, *even if* Imaeda could be modified to include switch SW17, no teaching exists for automatically switching switch SW17 in conjunction with the switch 64, i.e., the alleged claimed first switch, of Imaeda in response to a selected mode. Furthermore, paragraph 74 of Sawachi does not teach or suggest that switches SW1 and SW2 are **simultaneously switched automatically in conjunction with** a switching of said first switch in response to a selected mode. It is clear from the Abstract and from paragraphs 74-78 that, although switches SW1 and SW2 may be switched automatically, they are not done so simultaneously in conjunction with each other. Instead, they are switched independently of one another.

D. Claims 18-22

Applicants submits that claims 18- 22 are patentable at least by virtue of their respective dependencies

II. Claim Rejections Under 35 U.S.C. § 103 to Claims 3-5, 7, 9, 10, 13, 16 and 17

Claims 3-5, 7, 9, 10, 13, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imaeda and Sawachi, and in further view of Fernandez et al. (US Patent 6,339,842), herein Fernandez. Applicants traverse the rejection based on the following comments.

A. Claim 3

Claim 3 recites:

wherein said TV telephone processing section comprises:

a first memory;

a first input circuit connected to said display data generating section, wherein said first input circuit receives said first display data from said display data generating section, carries out a first converting process to said first display data to generate converted display data, and to store in said first memory;

a motion picture CODEC circuit which receives compressed motion picture data from a counter end, expands said received compressed motion picture data into expanded motion picture display data, and stores in said first memory;

a camera;

a second input circuit connected to said camera, wherein said second input circuit receives motion picture display data from said camera, carries out a second converting process to said motion picture display data to generate converted motion picture display data, and to store in said first memory; and

a combining circuit which reads out said converted display data, said expanded motion picture display data and said converted motion picture display data from said first memory to combine into said second display data, and outputs said second display data to said first switch. (emphasis added)

Thus, claim 3 relates to a TV telephone processing section, which explicitly relates to the use of TV telephone function (*see e.g.*, claim 1). Thus, the first input circuit is a feature of the

TV telephone processing section, as explicitly recited in claim 3. However, in the Response to the Arguments section of the current Office Action, the Examiner disagrees. The Examiner asserts that claim 1 states that the first display data is displayed in “general use mode” and the TV telephone function is not used. The Examiner is improperly reading in limitations that are not recited in the claims.

For example, claim 1 recites, *inter alia*:

An information communication terminal with a TV telephone function,
comprising:
a display data generating section which generates first display data
in a general use mode in which a TV telephone function is not used;
a TV telephone processing section which generates second display
data in a TV telephone use mode in which the TV telephone function is used.

The recitation of “in which a TV telephone function is not used” merely describes what a “general use mode” is. Claim 1 **does not exclude** the generation of the first display data for use in both the general use mode and the TV telephone function. In fact, “comprising” is known to be an “open-ended” non-limiting term.

Turning to claim 3, claim 3 clearly requires the use of the first display data by the first input circuit of the TV telephone processing section which is used for the TV telephone function (i.e., for generating the second display data). In particular, the first display data is converted into converted display data and then the converted display data is combined with other display data by the combiner circuit to generate the second display data (see Figure 1). Thus, the second display data is generated in part from the first display data. **In summary, the first input circuit is a feature of the TV telephone processing section.**

With regard to “a first input circuit connected to said display data generating section, wherein said first input circuit receives said first display data from said display data generating

section, carries out a first converting process to said first display data to generate converted display data, and to store in said first memory,” the Examiner asserts that TV reception circuit 60 of Imaeda teaches this feature. However, the above feature of claim 3 relates to the TV telephone processing section, which the Examiner asserts is taught by the video decoding circuit 36 of Imaeda in the rejection of claim 1². The TV reception circuit 60 of Imaeda, however, is not related to the video decoding circuit 36. That is, the TV reception circuit 60 does not provide a signal to the video decoding circuit 36, but merely inputs a TV reception signal to the monitor 20 when in a non-communication state (col. 3, line 24 to col. 4, line 23; col. 6, lines 35-67; and Fig. 7). Furthermore, **the TV reception circuit 60 is not utilized during the communication state** (i.e., when video from the video decoding circuit 36 is displayed on the monitor 20), and thus, would not be combined with other types of display data during the communication state.

With regard to “a second input circuit connected to said camera, wherein said second input circuit receives motion picture display data from said camera, carries out a second converting process to said motion picture display data to generate converted motion picture display data, and to store in said first memory,” the Examiner asserts that the video data from camera 12 of Imaeda teaches this feature. However, Imaeda teaches that a video encoding circuit 32 connected to camera 12, encodes an output video image of the camera 12 for communication (col. 3, lines 15-17). In other words, the video data from camera 12 is sent to the communication partner through the communication control 72 **and the communication line**

² Thus, the Examiner relies on both the TV reception circuit 60 and the video decoding circuit 36 of Imaeda to teach the claimed TV telephone processing section.

(Fig. 7). Imaeda does not teach or suggest that the video data from camera 12 is input to the video decoding circuit 36, **or even to the monitor 20 for that matter**. Instead, this video data is sent to a user at the other end of the communication line. **Thus, there is no teaching to combine the video data from camera 12 with the video data from the video decoding circuit 36.** The Examiner's application of these features does not and cannot form the claimed invention.

In view of the above, Fernandez fails to correct the deficiencies of Imaeda and Sawachi. Therefore, Imaeda, alone or in combination with Sawachi and Fernandez, fails to teach or suggest each and every feature of claim 3.

B. Claim 7

Claim 7 includes analogous, though not necessarily coextensive features recited in claim 1, and therefore, claim 7 is patentable for similar reasons discussed for claim 1.

C. Claim 9

Applicants submit that claim 9 is patentable for reasons similarly presented in conjunction with claim 3.

D. Claim 17

Claim 17 recites "supplying electric power for said TV telephone function automatically occurs in conjunction with said connecting said second display data to said display." Therefore, Applicants submit that claim 17 is patentable for reasons similarly presented in conjunction with claim 14.

E. Remaining claims

Applicants submits that the remaining claims are patentable at least by virtue of their respective dependencies.

III. Claim Rejections Under 35 U.S.C. § 103 to Claims 6 and 11

Claims 6 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imaeda in view of Sawachi and Fernandez, further view of Allen et al. (US Patent Application Publication No. 2003/0041333), herein Allen. However, Allen does not correct the deficiencies of Imaeda, Sawachi, and Fernandez with respect to claims 1, 3, 7 and 9. Therefore, claims 6 and 11 should be patentable at least by virtue of their respective dependencies.

IV. Claim Rejections Under 35 U.S.C. § 103 to Claims 12 and 25

Claims 12 and 25 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imaeda in view of Sawachi, further in view of Yap et al. (US Patent Application Publication No. 2003/0043260), herein Yap. However, Yap does not correct the deficiencies of Imaeda and Sawachi with respect to claim 1. Therefore, claims 12 and 25 should be patentable at least by virtue of their dependency upon claim 1.

V. Claim Rejections Under 35 U.S.C. § 103 to Claim 15

Claim 15 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imaeda in view of Sawachi and Fernandez, in view of Yap. However, Yap does not correct the deficiencies of Imaeda, Sawachi and Fernandez with respect to claim 7. Therefore, claim 15 should be patentable at least by virtue of its dependency upon claim 7.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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